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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,828	01/11/2001	David M. Szum	P 273739 D807-CIP-III-CON	1573

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EXAMINER
LEE, JOHN D

ART UNIT	PAPER NUMBER
2874	

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/757,828	Applicant(s) David M. Szum et al.
	Examiner John D. Lee	Art Unit 2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *73-98* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) *73, 76-83, 85-91, 93, and 98* is/are allowed.

6) ☒ Claim(s) *74, 75, 84, 92, and 94-97* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *7, 10*

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

This application is a continuation of application Serial Number 09/035,771, filed on March 6, 1998, which issued as U.S. Patent 6,298,189 on October 2, 2001. The substitute specification filed in the present application on August 10, 2001, has been entered. It is noted that this substitute specification involves no changes other than the adjustment of page margins. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The eleven (11) sheets of drawing filed with this application are acceptable.

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 74, 75, 84, 92, 95, and 96 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 74 is indefinite because it depends from a canceled claim (claim 1). For examination purposes, it is assumed that claim 74 is intended to depend from claim 73. Claim 75 depends from claim 74 and thus inherently contains the same indefiniteness. In the first line of claim 84, the reference to "said primary coating layer (b)" is unclear since no alpha designations were previously employed. The claim is thus indefinite. It is suggested that "(b)" be deleted from this phrase. Claim 92 is indefinite because there is no antecedent support for the term "the one or more monomer diluents" (lines 1-2 and 2-3). Claim 95 is indefinite because it depends upon itself. For examination purposes, it is assumed that claim 95 is intended to depend from claim 94. Claim 96 depends from claim 95 and thus inherently contains the same indefiniteness.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 94-96 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent 5,373,578 to Parker et al. See the discussion in the Patent from column 3 (line 63) to column 5 (line 20). Parker et al clearly discloses the same method as set forth by applicant in claims 94-96. Note that the temperature at which the stripping takes place is 100° C, that an optional wipe of the stripped fiber portion with an alcohol-moistened swab can be made, and that the stripped fiber portion exhibits little or no residue of the primary coating material.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR § 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR § 3.73(b).

Claim 97 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 80 of copending Application No. 09/757,533. Although the conflicting claims are not identical, they are not patentably distinct from each other

because the only difference is the recitation in present claim 97 that the adhesion test force of the primary coating material is "as measured by peel back test at 50% relative humidity". Since this would be understood by a person of ordinary skill in the art to be a standard reference for measurement of the adhesion test force, and since there are no structural distinctions between the fiber of instant claim 97 and that of claim 80 of copending Application No. 09/757,533, the two claims are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 73, 76-83, 85-91, 93, and 98 are allowed. The prior art fails to disclose or suggest an optical fiber having a cured primary coating thereon, wherein the coating possesses the properties set forth in these claims. The prior art also fails to disclose or suggest a method for preparing a coated optical fiber which involves the specific steps set forth in claim 98. Further discussion regarding the distinctions of the coated optical fibers of this application from the prior art can be found in the file record of copending application Serial Number 09/757,533.

For the same reasons, claims 74, 75, 84, and 92 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office action.

The prior art documents submitted by applicant in the Information Disclosure Statements filed on August 10, 2001, and December 7, 2001, have mostly been considered and made of record (note the attached copy of forms PTO-1449). Ten (10) foreign patent documents and one (1) non-patent publication cited in the August 10, 2001, Statement were not considered (non-initialed on form PTO-1449), since copies thereof were not provided and since these documents were not cited in the parent

application (Serial Number 09/035,771, filed on March 6, 1998). If applicant wishes these documents to be considered, copies thereof must be submitted.

It is noted that the claims of the instant application were "copied from and/or patterned after claims of U.S. Patent No. 6,014,488", although applicant does not specifically state that an interference with said U.S. Patent is desired. It is further noted that this application (including the claims presented) is remarkably similar to copending application Serial Number 09/757,533, which is awaiting the institution of an interference with U.S. Patent No. 6,014,488. Clarification is thus required as to whether applicant intends the present application to be joined in any such interference proceedings. Applicant should also notify the Examiner if there are any other (as yet unexamined) similar applications which should also be so joined.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. §§ 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Any inquiry concerning the merits of this communication should be directed to Examiner John D. Lee at telephone number (703) 308-4886. The Examiner's normal work schedule is Tuesday through Friday, 6:30 AM to 5:00 PM. Any inquiry of a general or clerical nature (i.e. a request for a missing form or paper, etc.) should be directed to the Technology Center 2800 receptionist at

telephone number (703) 308-0956, to the technical support staff supervisor (Team 2) at telephone number (703) 308-3072, or to the Technology Center 2800 Customer Service Office at telephone number (703) 306-3329.

John D. Lee
John D. Lee
Primary Patent Examiner
Group Art Unit 2874